

## **REMARKS/ARGUMENTS**

Claims 37-45 are pending in the present application. Claims 1-36 were canceled. No claims were amended. Claims 37-45 were added. Reconsideration of the claims is respectfully requested.

Applicants are not conceding in this application that the claims as presented prior to this amendment are not patentable. The present claim amendments are only for facilitating expeditious prosecution of the claims. Applicants respectfully reserve the right to pursue these and other claims, including the subject matter encompassed by claims 1-36 as presented prior to this Amendment, in one or more continuations and/or divisional patent applications.

Support for the new claims may be found in the claims as originally presented, as well as in the specification, at least in [0039], lines 1-2, [0040], lines 1-2, [0031], [0032], FIG. 6A-6D, [0043], lines 6-12, and [0045], lines 1-12.

Reconsideration of the claims is respectfully requested.

### **I. 35 U.S.C. § 103, Obviousness**

The Examiner has rejected claim 36 under 35 U.S.C. § 103 as being unpatentable over Briggs et al., U.S. Patent No. 7,080,139 (hereinafter “Briggs”), in view of Herf et al., U.S. Patent Application Publication No. 2005/0021624 (hereinafter “Herf”), and further in view of Marston et al., U.S. Patent Application Publication No. 2004/0260710 (hereinafter “Marston”), and further in view of Bogard, U.S. Patent No. 6,757,365 (hereinafter “Bogard”), and further in view of St. John et al., U.S. Patent Application Publication No. 2006/0004702 (hereinafter “St. John”), and further in view of Solomon, U.S. Patent Application Publication No. 2005/0164154 (hereinafter “Solomon”). This rejection is respectfully traversed.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). The prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). In determining obviousness, the scope and content of the prior art are... determined; differences between the prior art and the claims at issue are... ascertained; and the level of

ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. *Graham v. John Deere Co.*, 383 U.S. 1 (1966). “Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l. Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007). “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *Id.* (citing *In re Kahn*, 441 F.3d 977, 988 (CA Fed. 2006)).”

In the Office Action of March 17, 2009, the Examiner stated that “[t]he applicants further state that with their invention, the user can assign topic tags before/and or after a chat, select from a list of topics before/and or after a chat, or applicant’s can automatically assign topic tags that can alter be used to search topics” but “[t]his statement is irrelevant, because it is not part of the claim. New claims 37-45 recite the forgoing limitations. First, independent claims 37, 40, and 43 recite “wherein the instant messaging service is adapted to accept the third input before the instant messaging session begins, during the instant messaging session, and after the instant messaging session.” Applicants submit that the art of record, individually or in combination is silent as to this limitation.

Second, independent claims 37, 40, and 43 recite “responsive to the acceptance, automatically inserting the topic tag, by the processor, into the text of the instant messaging session when a turn is identified by the processor.” Applicants submit that the art of record, individually or in combination, is silent as to this limitation.

Third, claims 39, 41, and 45 recite “saving a transcript of the instant messaging session to a repository; searching the repository for the topic tag; and responsive to determining that there is a match between the topic tag in the repository and an entry in an auto alert table, exporting an associated transcript segment to an e-mail.” Applicants submit that the art of record, individually or in combination, is silent as to this limitation.

Applicants further submit that the remaining claim limitations distinguish over the art of record, individually or in combination, at least because the art does not *explicitly* disclose the

claim limitations of claims 37-45. Applicants submit that the art of record discloses the following:

1. Briggs discloses “collecting data regarding a user’s computer usage experience and sharing that data” including data sharing by “buddies” that are “identified on buddy lists of instant messaging products.” Briggs, col. 2, lines 26-29.

2. Briggs discloses a graphical user interface on which predefined topics (891, 892) may be selected by a user using checkboxes, and where the user may add a topic area (893), Briggs, FIG. 8D.

3. Briggs’ graphical user interface states “[u]se the checkboxes below to select which topic areas you want to share by default. You’ll be able to turn these topic areas on or off for each user.” FIG. 8D.

4. Briggs states “[o]ne aspect of practicing the present invention can include tying into a user’s instant messaging products, or more generally, into the user’s messaging facilities.” Briggs, col. 4, lines 33-34.

5. Briggs states [b]uddies or groups of buddies are given defined rights to access tracking data collected from the user” and examples of content categories or topics can be found in FIG. 8D.” Briggs, col. 18, lines 19-23.

6. Briggs states “FIG. 8D is a topic sharing interface” with “[t]ick boxes 891 and topic or sub-topic names 892,” “[a]dditional topics” that “can be added to a list 893” and “a browser-style bookmark tree” that “can be used to select topics.” Briggs, col. 8, lines 42-47.

7. Briggs FIG. 9 is a user interface “for viewing activity of buddies” with “message tab 965” that “may provide access to a message repository.”

8. Herf discloses that chat participants “exchange chat conversations in combination with media, such as pictures” and automatically tracking “when a chat participant has changed focus to a different media item, such as a different picture, and causes that media, in association with corresponding chat text, on another chat participant’s terminal.” Herf, [0023], lines 2-9

9. Herf discloses “a chat client incorporates external media elements, such as video conferencing, picture sharing, and document (such as an image, a text file, a presentation, a web page, a search result, or a blog) sharing, in conjunction with the conversation between the participants of the chat in real time, such that users involved in the chat may interactively display

(or otherwise input) media with each other while they communicate via ext, voice (e.g., voice over-IP), etc.” Herf, [0025], lines 1-10.

10. Herf discloses that “chat history is aligned with such concurrent media sharing history, such that, for example, a user can glance back and understand the conversation topic, and its history of textual and media sharing information as aligned with each other.” Herf, lines [0025], lines 10-14

11. Herf discloses that “a ‘snapshot’ may be taken of the state of the system when each comment is made, and if the snapshot has changed substantially since the previous line in the conversation, this change is indicated with a thumbnail represent the change.” Herf, [0026], lines 2-6

12. Herf discloses “a view of the remote user’s screen, which may be expressed as a thumbnail that changes as the remote user changes focus (or view) in a shared list of pictures.” Herf, [0031] 1-3

13. Herf discloses that “one use can (select to) view in real-time what the other chat user is currently viewing (to ‘follow’ the other user’s action with respect to shared media)....” Herf, [0034], lines 6-9.

14. Herf discloses “a message area 237” where “the local user can type in or otherwise enter chat text to be sent to the remote user” and if the user is focusing on a different image than that previously chatted, “activation of a send button 240 causes the image identifier associated with the mage displayed in the current view area 208 to be automatically sent in conjunction with the corresponding chat text entered in the message area 237.” Herf, [0054], lines 1-10.

15. Solomon discloses “a customized demand-initiated e-learning system architecture.” Solomon, [0009], lines 3-4.

16. Solomon discloses that two individuals can “enter a multi-phasal process of argumentation” where “individual 1 presents argument A on Topic 1 to individual 2,” individual 2 responds with Argument B on Topic 1 to individual 1” and so forth where the topic changes. Solomon, [0124], lines 1-7.

17. St. John discloses “an auto alert generated by the document server is sent to the client manager” where the auto-alert contains at least the item identifier of the involved information item, and the category of the term(s) that triggered the auto-alert” and where the client manager generates an auto alert message. St. John, [0063], lines 3-11.

18. Bogard discloses a conversation transcript in connection with registration for an IM service. Bogard, col. 10, lines 19-38.

None of the cited art, individually or in combination *explicitly* discloses the limitations of claims 37-45. Since the claim limitations are not disclosed explicitly, the Examiner must show that the limitations are disclosed inherently. Applicants submit that the cited art also cannot disclose the claim limitations inherently. First, the Examiner has not set forth an inherency argument. Second, an inherency argument cannot be made because it cannot be shown that the claim limitations would necessarily follow from any of the references.

The Examiner must provide a rationale or evidence to show inherency. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)

Since the claim limitations are neither explicitly disclosed nor inherently disclosed, claims 37-45 are in condition for allowance.

## II. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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